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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,213	12/16/2003	Frederick Douglass	YOR920030576US1	7687
35526	7590	07/29/2011	EXAMINER	
DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			CASANOVA, JORGE A	
			ART UNIT	PAPER NUMBER
			2159	
			NOTIFICATION DATE	DELIVERY MODE
			07/29/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/737,213	<b>Applicant(s)</b> DOUGLIS ET AL.	
	<b>Examiner</b> JORGE A. CASANOVA	<b>Art Unit</b> 2159	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-15, 17-20, 24-34 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34 is/are rejected.
- 7) ☒ Claim(s) 1-3, 7-15, 17-20, 24-33 and 37-40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 13<sup>th</sup>, 2011 has been entered.

### ***Response to Amendment***

2. In response to the BPRAI Decision dated on April 13th, 2011, claims 1, 18, 24 and 34 were amended and 37-40 were newly added.

### ***Examiner's Remarks***

3. Multiple attempts to address the following *35 USC § 101 rejection* were made via Telephonic Communication, however, the Applicants never returned the Examiner's call to address the *35 USC § 101* issue that was still outstanding and to place the application in condition for allowance. Due to Office time constraints a Non-Final after RCE Office action is being mailed out.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 34 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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6. With respect to claim 34, the claim is drawn to a computer program product, the claim fails to place the invention squarely within one statutory class of invention. The computer program product while being tied to a “computer readable storage media,” still does not squarely fall within one statutory class of invention because on page 16, lines 12-16 of the instant specification it is recited, “Examples of computer readable media include recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and transmission-type media, such as digital and analog 15 communications links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions,” the Applicant has provided evidence that applicant intends the “computer readable storage media” to include signals (i.e., propagate, electromagnetic, infrared, or propagation medium). Signals are not one of the four categories of invention (i.e., process, machine, manufacture, or composition of matter) and therefore the claims are not statutory. Signals are not a series of steps or acts and thus are not a process. Signals are not a physical article or object and as such are not a machine or manufacture. Signal are also not a combination of substances and therefore not a composition of matter. Further, in such embodiments, the “computer program product” is still unable to act as a computer component and have its functionality realized. Also, “A transitory, propagating signal is not a ‘process, machine, manufacture, or composition of matter.’ Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. §101; thus, such a signal cannot be patentable subject matter.” See *In re Nuijten*, 84 USPQ2d 1495 (Fed. Cir. 2007). During Telephonic Communications the

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Examiner recommended reciting “non-transitory computer readable storage media” in order to obviate the above rejection.

***Allowable Subject Matter***

***Reasons for Indicating Allowable Subject Matter***

7. Claims 1-3, 7-15, 17, 18-20, 24-33 and 37-40 are being objected to for having allowable subject matter. Claim 34 is being rejected under *35 USC § 101*, as referenced above.

8. The following is a statement of reasons for the indication of allowable subject matter:

The Examiner has considered the Applicant's arguments, see pages 10-17 of the *Remarks*, and is persuaded. With the exception of the outstanding *35 USC § 101* issue (see claim 34), as referenced above, the Examiner maintains that the prior arts of record alone or in combination do not teach or fairly suggest the combination of elements as currently recited by the claims, thus, placing the application in condition for allowance, upon addressing the *35 USC § 101* issue cited above.

***Conclusions/Points of Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JORGE A. CASANOVA whose telephone number is (571)270-3563. The examiner can normally be reached on Mon. - Fri., 7:15 a.m. - 5:45 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James K. Trujillo can be reached on (571) 272-3677. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JORGE A CASANOVA/  
Examiner, Art Unit 2159